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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,209	08/15/2003	Alexander Zernickel	ZERNICKEL-2	4020
20151	7590	07/27/2004	EXAMINER	
HENRY M FEIEREISEN, LLC			JOYCE, WILLIAM C	
350 FIFTH AVENUE			ART UNIT	
SUITE 4714			PAPER NUMBER	
NEW YORK, NY 10118			3682	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/643,209

Applicant(s)

ZERNICKEL ET AL.

Examiner

William C. Joyce

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 9-17, 20 and 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 18, 19 and 21 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This is the First Office Action in response to the Election filed on July 14, 2004.

Election/Restrictions

1. Claims 9-17, 20, and 22-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 14, 2004.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7, 18, 19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 27 05 331.

The prior art to DE '331 illustrates a linear guide for transmitting a torque between a tubular housing, which is defined by a longitudinal axis and rotatable about the longitudinal axis, and a shaft, which is received in the housing and movable in the direction of the axis in relation to the housing, said linear guide comprising plural axial rolling bearings received in the housing in surrounding relationship to the shaft, wherein the plural axial rolling bearings are disposed in two radial planes in axial spaced-apart relationship, a center axis of the rolling bearing is shifted in parallel relationship at an

offset to a normal upon a longitudinal shaft axis, wherein the bearing member has a cup-shaped configuration to define a convex surface for supported by a surface area of the shaft.

Using a linear guide/slide in combination with a vehicle steering column was well known in the art. Official Notice is taken with respect to the limitation defining the guide device used in combination with a steering column. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the guide of DE '331 in combination with a steering column, motivation being to provide a collapsible steering column having little backlash.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 18, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mainardi (USP 5,620,259).

Mainardi illustrates a linear guide for transmitting a torque between a tubular housing, which is defined by a longitudinal axis and rotatable about the longitudinal axis, and a shaft, which is received in the housing and movable in the direction of the axis in relation to the housing, said linear guide comprising plural axial rolling bearings received in the housing in surrounding relationship to the shaft, wherein the plural axial rolling

bearings are disposed in two radial planes in axial spaced-apart relationship, a center axis of the rolling bearing is shifted in parallel relationship at an offset to a normal upon a longitudinal shaft axis, wherein the bearing member has a cup-shaped configuration to define a convex surface for supported by a surface area of the shaft.

Mainardi illustrates the rolling bearings as a cup shaped member (6) rotatably supported in the housing by ball bearings (7), but does not clearly show the rolling bearings having two bearing members and a set of rolling bodies disposed between the bearing members. However, it was well notoriously known in the art to provide ball bearings with an outer race member press fitted into a housing so as to define a raceway for the ball bearings. Official Notice is taken with respect to the limitation defining the press-fitted bushing to provide a raceway for the ball bearings. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide separate outer raceways tightly fitted into the housing of Mainardi, motivation being to provide a modular ball bearing arrangement for supporting the rolling bodies.

Using a linear guide/slide in combination with a vehicle steering column was well known in the art. Official Notice is taken with respect to the limitation defining the guide device used in combination with a steering column. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the guide of Mainardi in combination with a steering column, motivation being to provide a collapsible steering column having little backlash.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Joyce whose telephone number is (703) 305-5114. The examiner can normally be reached on Monday - Thursday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on (703) 308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William C. Joyce